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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,013	11/20/2000	Keunsuk P. Chang	361752000500	7915

25227 7590 06/13/2003

MORRISON & FOERSTER LLP  
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EXAMINER
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FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/13/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/715,013	CHANG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lawrence D Ferguson	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20,24-44 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20,24-44 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>17</u> . | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

1. This action is in response to the amendment mailed March 19, 2003.  
Claims 23 and 45 were cancelled and claims 1, 3, 25 and 27 were amended rendering claims 1-20, 24-44 and 46 pending. Acknowledgement is made of the Declaration by Ken Kurokawa and supplemental Declaration by Keunsuk Chang.

***Claim Rejections – 35 USC § 103(a)***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:  

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-8 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. (U.S. 5,137,955) as previously stated in the Office Action submitted on November 19, 2002. Regarding newly added limitation of 'a polyolefin resin layer substantially free from slip additives,' Tsuchiya is silent of slip additives, therefore meeting this amended limitation of claims 1 and 3. Additionally, Applicant amends to disclose '...wherein said discharge-treated surface is formed in an atmosphere consisting essentially of CO<sub>2</sub> and N<sub>2</sub> to form said nitrogen functional groups and wherein the laminate film has a barrier durability under 9% elongation of 46.5 cc/m<sup>2</sup>/day or less

oxygen transmission rate through the laminate film' is held to be a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Process limitations are given little patentable weight in product claims.

***Claim Rejections – 35 USC § 103(a)***

4. Claims 9, 17-18, 33 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. (U.S. 5,137,955) in view of Kurokawa et al (U.S. 5,698,317) as previously stated in the Office Action submitted on November 19, 2002.

***Claim Rejections – 35 USC § 103(a)***

5. Claims 19-20 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. (U.S. 5,137,955) in view of Tanizaki et al (U.S. 5,998,039) as previously stated in the Office Action submitted on November 19, 2002.

***Claim Rejections – 35 USC § 103(a)***

6. Claims 24 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. (U.S. 5,137,955) in view of Yokoyama et al (U.S. 5,939,205) in further view of Akao et al. (U.S. 5,492,741) as previously stated in the Office Action submitted on November 19, 2002.

***Claim Rejections – 35 USC § 103(a)***

7. Claims 25-32 and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. (U.S. 5,137,955) in view of Yokoyama et al (U.S. 5,939,205) as previously stated in the Office Action submitted on November 19, 2002. Regarding newly added limitation of 'a polyolefin resin layer substantially free from slip additives,' Tsuchiya is silent of slip additives, therefore meeting this amended limitation. Additionally, Applicant amends to disclose '...wherein said discharge-treated surface is formed in an atmosphere consisting essentially of CO<sub>2</sub> and N<sub>2</sub> to form said nitrogen functional groups' is held to be a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966.

***Response to Arguments***

8. The objection to the specification is withdrawn due to clarification of Applicant.

Regarding newly added limitation of 'a polyolefin resin layer substantially free from slip additives,' Tsuchiya is silent of slip additives, therefore meeting this amended limitation of claims 1 and 3. Additionally, Applicant amends to disclose '...wherein said discharge-treated surface is formed in an atmosphere consisting essentially of CO<sub>2</sub> and N<sub>2</sub> to form said nitrogen functional groups and wherein the laminate film has a barrier durability under 9% elongation of 46.5 cc/m<sup>2</sup>/day or less oxygen transmission rate through the laminate film' is held to be a product by process claim limitation. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Process limitations are given little patentable weight in product claims. Therefore the limitations of claims 25 and 27 are maintained. Mr. Kurokawa's Declaration has been considered; however does not overcome the prior art due to lack of clarity. Large portions of the Declaration are not translated and the Declaration lacks reasons in overcoming the present rejections. Mr. Chang's supplemental Declaration has been considered but is not found persuasive. Mr. Chang argues Tsuchiya's film design requires the use of an additive slip agent. This

arguments lacks support because neither Tsuchiya nor Mr. Chang provide a showing that glyceryl tri-12-hydroxystearate is defined as a slip agent. There is nowhere in Tsuchiya's disclosed invention the admission of slip agent(s). Mr. Chang argues (paragraph 11 of supplemental Declaration) the present metallized film has a significantly thicker aluminum layer than Comer (U.S. 6,139,930). This argument lacks merit and is moot because Comer is not a cited reference of the instantly claimed prior art.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for

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After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

